

Appl. No. 09/827,108  
Amdt. dated February 16, 2005  
Reply to Office action of January 4, 2005  
Page 2

### **REMARKS**

#### **1. Finality is Premature**

The Examiner has introduced a new ground of rejection, namely a rejection under 35 USC 112, second paragraph and asserted that the new ground of rejection was necessitated based upon "Applicant's amendment." The **only** amendment to the claim was to add the word "the" prior to the second occurrence of the term "electrode assembly" in the last paragraph of claim 1. This amendment simply corrected an obvious grammatical oversight.

Prior to the Amendment, the relevant language read:

"adapted to slidably engage an electrode assembly and having a terminal end such that advancement of electrode assembly . . . causes separation of the electrode assembly."

After the amendment, the relevant language reads:

"adapted to slidably engage an electrode assembly and having a terminal end such that advancement of **the** electrode assembly . . . causes separation of the electrode assembly." (Emphasis added)

Thus, a term (electrode assembly) is introduced in this paragraph and modified by the term "an"; it is used twice thereafter in the same paragraph, once with the modifier "the" and once without.

There is no reasonable argument that could be made as to why correcting the grammatical oversight would "necessitate a new ground of rejection." To the extent the Examiner wanted to make the rejection under section 112 previous to this action; the absence of the word "the" certainly did not preclude such a rejection.

Appl. No. 09/827,108  
Amdt. dated February 16, 2005  
Reply to Office action of January 4, 2005  
Page 3

Furthermore, according to MPEP 706.07(a), the Examiner may not make a rejection final based upon any amendment "that should reasonably have been expected." It is reasonable to expect that a grammatical oversight may be corrected.

In summary, a new ground of rejection was introduced that was not necessitated by any amendment made by Applicant. As such, the finality of the Office Action is premature and Applicant respectfully asserts that it must be withdrawn.

**2. Rejection under 35 USC 112, second paragraph is improper**

Separate from the fact that the introduction of a new ground of rejection in this instance precludes making this Office Action final, the rejection itself is unclear and respectfully traversed by the Applicant.

The current position of the Examiner would appear to be that language within the claims can be selectively considered or discounted (e.g., labeled as hypothetical) based upon whether or not such language is directed to an "intended use" as opposed to functional language. Furthermore, the Examiner appears to be under the impression that determining whether such language is in fact directed towards an "intended use" or functionally defines an element is a subjective analysis. Again, the Applicant respectfully traverses this as being unsupported by the law and rules of patent practice. Finally, it appears that part of the Examiner's analysis is focused on form over substance; namely that the claimed element "electrode assembly" is introduced in the same paragraph as the coupling member.

**A) Functional Language Versus Intended Use**

Both Applicant and the Examiner have quoted the relevant sections of the MPEP with respect to functional language. Applicant respectfully suggests that the Examiner is still treating both concepts in the same manner. Functional language defines an element of the claim by what it does rather than what it is,

Appl. No. 09/827,108  
Amdt. dated February 16, 2005  
Reply to Office action of January 4, 2005  
Page 4

(but nevertheless, still defines an element) whereas intended use defines what may be done with a claimed structure.

As a hypothetical, consider a claim to a hammer comprising a handle attached to a metal head having a planar surface parallel to the handle. The elements of the claim are a handle, head and planar surface. If a claim were presented to the effect of a hammer comprising a handle attached to a metal head having a planar surface parallel to the handle, wherein the hammer is capable of striking and breaking glass, the Examiner would be justified in rejecting such a claim over a prior art reference teaching a hammer having the same handle, head and planar surface even though the reference only teaches using the hammer to drive a nail. In other words, the only difference is the intended use of the structure, which in and of itself is identical to that disclosed in the hypothetical prior art.

Now consider a claim to a hammer comprising a handle attached to a metal head having a planar surface parallel to the handle, wherein striking an object with the planar surface causes the planar surface to move to a perpendicular position with respect to the handle during the strike and returning to a parallel position immediately thereafter.

Now, a rejection over the prior art hammer would be inappropriate because it does not teach *structure* that permits the planar surface from pivoting during the strike. This would be an example of defining structure by its function rather than by listing its physical components. For example, the above claim could be alternatively presented as a head pivotally coupled with the handle or a hammer having a handle, a head and a spring loaded hinge element coupling the head to the handle. To begin a comparison to the current case, a hypothetical Examiner may take an extreme position and state that the prior art hammer could be broken during use and thus the head can be placed in any position relative to the handle desired and the hypothetical claim language directed to "returning to a parallel position immediately thereafter" is only "intended use" and thus is ignored. In such a case, the examination does not really consider the *structure*

Appl. No. 09/827,108  
Amdt. dated February 16, 2005  
Reply to Office action of January 4, 2005  
Page 5

that is defined by the functional language as is required but is only selectively picking and choosing portions of the claims language and discarding the reset.

Though it should be readily apparent, Applicant hereby states that the presentation of this "hypothetical" claim and any comparisons drawn to the pending claims is purely and solely to facilitate Applicant's arguments with respect to the general concept of functional language and should in no way imply or suggest any limitation or interpretation of the actual claims, their elements or their scope.

With respect to claim 1, the structure included is a coupling member that engages an electrode assembly such that advancing the electrode assembly past the terminal end while within a vasculature structure causes the engaged electrode assembly to separate. This is not an intended use; rather, the coupling member includes structure that facilitates this engagement and separation as claimed. The references lack such a teaching.

#### **B) All Element of Claim Must Be Considered**

Again referring to claim 1, the elements of the claim include a guiding device, fixation member, coupling member and an electrode assembly. Applicant is again unaware of any basis that permits the Examiner to state that the claimed "electrode assembly" is hypothetical and thus, a reference not teaching the same somehow anticipates the claim.

The claim includes both a coupling member and an electrode assembly. Furthermore, the coupling member includes structure that permits the claimed engagement and separation of the electrode assembly from the coupling member. It is this structure that has repeatedly be overlooked by the Examiner.

Applicant respectfully suggests that perhaps the Examiner's position is based on form over substance. To clarify, the Examiner is asked to consider if claim 1 was rewritten as follows, would the Examiner's concerns be addressed:

Appl. No. 09/827,108  
Amdt. dated February 16, 2005  
Reply to Office action of January 4, 2005  
Page 6

A system for use in deploying one or more electrode assemblies, comprising:

an elongated guiding device having a proximal end and a distal end, deployable within a vascular structure;

an expandable fixation member coupled to the distal end such that selective expansion of the fixation member secures the elongated guiding device within the vascular structure at a given position;

an electrode assembly; and

a coupling member adjacent to the elongated guiding device adapted to slidably engage the electrode assembly and having a terminal end such that advancement of the electrode assembly distal to the terminal end causes separation of the electrode assembly from the coupling member within the vascular structure, whereby the electrode assembly may be located at a predetermined site of implant while the fixation member is expanded.

If the above presentation satisfies the Examiner's objections, the Applicant respectfully asserts that the issue has more to do with presentation than substantive claim analysis. Specifically, there is no rule that each element must be set out alone or that precludes the introduction of more than one element in a given paragraph or passage. In summary, the electrode assembly is claimed and must be considered; the coupling member is claimed and must be considered and such consideration must be done based upon an understanding of the structure of the coupling member as defined by the functional language.

Appl. No. 09/827,108  
Amdt. dated February 16, 2005  
Reply to Office action of January 4, 2005  
Page 7

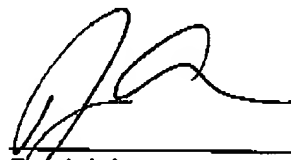
With respect to the remainder of the rejections, Applicant incorporates the remarks from the previous response.

Applicant respectfully asserts that the pending claims are in condition for allowance and notice of the same is respectfully requested. Should any issues remain, the Examiner is respectfully urged to telephone the undersigned to expedite prosecution.

Respectfully submitted,

Date

*2/16/05*



Daniel G. Chapik  
Reg. No. 43,424  
(763) 514-3066  
Customer No. 27581